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In re Application of	:	
Ofek et al.	:	
Application No. 09/535,831	:	DECISION ON PETITION
Filed: 03/28/2000	:	UNDER 37 CFR 1.137(a)
Attorney Docket No. SYN 1756	:	

This is a decision on the renewed petition under 37 CFR 1.137(a), filed March 26, 2007, to revive the above-identified application.

The application became abandoned for failure to file a timely and proper reply within the meaning of 37 CFR 1.113 to the final Office action, mailed December 3, 2003, which set a shortened statutory period for reply of three (3) months. Applicants obtained an extension of time for response within the third month pursuant to 37 CFR 1.136(a). Accordingly, the application became abandoned on June 4, 2004. On January 17, 2006, applicants filed a petition under 37 CFR 1.137(a), which was dismissed by the decision of February 21, 2007.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be entitled "Renewed Petition under 37 CFR 1.137."

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed.
- (2) The petition fee as set forth in 37 CFR 1.17(l);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unavoidable.
- (4) Any terminal disclaimer (and fee set forth in § 1.20(d)) required pursuant 37 CFR 1.137(d).

This petition does not meet the showing as to item (3)<sup>1</sup> above.

The Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to be "unavoidable." 35 U.S.C. § 133. Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present. In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

The showing of record is inadequate to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a). Specifically, an application is "unavoidably" abandoned where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, facsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

In the present petition, applicants asserted that the delay in prosecuting the present application was unavoidable and through no fault of applicants or their representatives. Applicants explained that the basis of the final rejection in the present application involved a question of inventorship between the present application and Patent No. 6,272,131. Applicants filed a petition under 37 CFR 1.324 in Patent No. 6,272,131 to add an inventor on June 3, 2004, which was granted by the decision of December 30, 2005. Applicants stated that they contacted the USPTO in writing to request the status of the petition under 37 CFR 1.324 for Patent No. 6,272,131 on October 7, 2005 and December 14, 2005. Copies of

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<sup>1</sup> Applicants asserted that the decision of February 21, 2007, stated that the previously filed petition under 37 CFR 1.137(a) lacked a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unavoidable. There appears to be some confusion as the statement in the decision that the "petition lacked item (3)." In actuality, the Office determined that applicants' petition did not meet the showing that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unavoidable. The Office apologizes for any misunderstanding.

the status inquiries accompany the petition. Additionally, applicants asserted that they “continued to prosecute Patent No. 6, 272,131,” by filing a substitute declaration and an assignment on February 3, 2006, and November 10, 2006, respectively. Applicants indicated that the issue of inventorship was resolved approximately 1.5 years after the petition under 37 CFR 1.324 was filed. Further, applicants averred that the examiners advised them that prosecution of this application could not proceed until the petition under 37 CFR 1.324 was decided by the Office because the question of inventorship was the only obstacle to the continued prosecution of the application. Applicants asserted that they repeatedly called the examiners and the Office of Petitions to advance the prosecution of this application, but the Office responded that there was nothing that could be done by the examiners or applicants until the Office acted on the petition under 37 CFR 1.324 in Patent No. 6,272,131.

Applicants asserted that the record shows that they took appropriate and diligent actions to ensure that a proper and timely response was submitted to the USPTO. Applicants averred that the delay was unavoidable because of the unforeseen faults and imperfections of the USPTO and its instrumentalities. Applicants argued:

In fact, the U.S.P.T.O. was undergoing major changes during the time that the Petition under 37 CFR 1.324 was filed: it was in the midst of moving its equipment and personnel to the new facilities in Alexandria. A certain amount of confusion at the Office was unavoidable. The move began in 2003 and was not completed until 2005. Applicants' respectfully submit that the Examiners' inability to locate the Petition, the Office of Petitions' inability to locate the Petition, and the Office's inability to timely process the Petition were all unavoidable. The postcard date-stamped January 6, 2006 from the U.S.P.T.O. stated that a request for a Certificate of Correction (instead of the Petition) had been received for Patent No. 6,272,131- this mistake was unintentional, avoidable and understandable. However, Applicants respectfully submit that they should not be penalized for the U.S.P.T.O's unavoidable, unforeseen faults and imperfections.

...

Filing an RCE would not have been an appropriate course of action, because at most, Applicants would have gained three months time to wait for the afore-mentioned Petition to be processed by the Office; at which time, the Office was unavoidably unable to process the Petition in a timely manner through the unforeseen fault or imperfection of the U.S.P.T.O and its instrumentalities. Filing an RCE would have resulted in another Final Rejection. The only way for Applicants to advance the prosecution of Serial Number 09/535,831 was to prosecute Patent No. 6,272,131; which they did.

*Petition dated 03/23/07, p.3.*

Again, the Office reminds applicants that it is incumbent upon an applicant to take steps to ensure against abandonment of an application. An applicant may delay action until the end of the time period for reply. In doing so, however, the applicant must assume the risk attendant to such delay. See Ex parte Warren, 1901 Dec. Comm'r Pat. 137 (Comm'r Pat. 1901). Here, applicants filed the petition

under 37 CFR 1.324 on June 3, 2004, the last day of the statutory period to reply to the final Office action. Applicants did not explain why they delayed filing the petition under 37 CFR 1.324 for almost six months after becoming aware of the issue of inventorship as stated in the Office action of December 3, 2003. Although applicants may have been in contact with the USPTO as to the status of the petition, the record does not show that applicants acted diligently to continue the prosecution of this application. By their own admission, applicants indicated that the only step they took to advance prosecution of this application was to prosecute Patent No. 6,272,131.

As to applicants' assertion that the examiners advised them that prosecution of this application could not proceed until the Office decided the petition under 37 CFR 1.324, the Office reminds applicants that reliance on oral advice by a USPTO employee does not render the delay unavoidable. As previously stated, there were several steps that applicants could have and should have taken to keep this application pending while also awaiting the outcome of the correction of inventorship in the patent. Applicants could have submitted a RCE (and fee) in response to the final Office action, accompanied by a request a suspension of action under 37 CFR 1.103 (c) (and fee). Additionally, applicants could have filed a request for an extension of time under 37 CFR 1.136(b) (and fee) due to USPTO delay pending the outcome of the 324 Request. Furthermore, applicants could have filed a continuing application. Although applicants argued that the filing of an RCE was not an appropriate course of action, applicants did not explain why they did not file one of the other types of replies to the final Office action available to them, as indicated above.

As to applicants' contention that the delay was unavoidable because of the unforeseen faults and imperfections of the USPTO and its instrumentalities, the Office reminds applicants that they bear the burden of proof, as well as the responsibility to ensure that any and all necessary actions were taken to continue the prosecution of this application. Applicants did not provide sufficient documentary evidence to establish that the delay was unavoidable due to the move by the USPTO to its new facilities in Alexandria, Virginia, or the processing of the papers in this matter.

A delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered "unavoidable" due to: (1) the applicant's reliance upon oral advice from Office employees; or (2) the Office's failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action. *See In re Sivertz*, 227 USPQ 255, 256 (Comm'r Pat. 1985); *see also In re Colombo, Inc.*, 33 USPQ2d 1530, 1532 (Comm'r Pat. 1994) (while the Office attempts to notify applicants of deficiencies in their responses in a manner permitting a timely correction, the Office has no obligation to notify parties of deficiencies in their responses in a manner permitting a timely correction).

Accordingly, the record reveals that applicants did not take appropriate and diligent actions to ensure that a proper and timely response was submitted in the USPTO so as to prevent the application from becoming abandoned. Applicants have not provided a sufficient showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable.

Therefore, the petition under 37 CFR 1.137(a) is again **dismissed**.

**Alternative Venue**

Applicants may wish to file a petition under 37 CFR 1.137(b) to revive the application on the basis of unintentional delay instead of submitting a renewed petition under 37 CFR 1.137(a).

A grantable petition under 37 CFR 1.137(b) must be accompanied by:

- (1) The reply required to the outstanding Office communication, unless previously filed.
- (2) The petition fee as set forth in 37 CFR 1.17(m) (**an additional \$770.00 for a small entity**); and
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional.

Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-3211.

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